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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,667	10/22/2001	Joshua Miles Chase	104348	5068
76863 7590 09/24/2008 KRAGULJAC & KALNAY 4700 ROCKSIDE ROAD SUMMIT ONE, SUITE 510 INDEPENDENCE, OH 44131			EXAMINER CHANKONG, DOHIM	
			ART UNIT 2152	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/029,667

Applicant(s)

CHASE ET AL.

Examiner

DOHM CHANKONG

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to Applicant's arguments filed on 6/20/2008. Claims 43-54 are presented for further examination.
2. This action is a final rejection.

Response to Arguments

3. Applicant argues that the rejection of claims 43, 48-50, and 52-54 under 35 U.S.C. §103(a) as being unpatentable over Schmid and Thompson is improper because the references are in conflict with one another. Where the teachings of two prior art references conflict, “the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art.” MPEP §2143.01(II). Thus, even if two prior art references conflict, this is not an automatic barrier to combinability. Rather, consideration must be paid to the possible solutions that the references would have suggested to one of ordinary skill in the art.

In Applicant’s view, Schmid is directed towards displaying advertising simultaneously with requested content while Thompson is directed to displaying advertising content before retrieval of requested content. Thus ends Applicant’s analysis. However, the analysis must proceed to consider what “the power of each reference” and what they may have suggested to one of ordinary skill in the art.

Here, as noted by Applicant in the remarks, Thompson discloses the claimed feature of intercepting a request before it reaches its intended destination address and delivers redirection information (a web page comprising links to additional advertisements to the client [see

Thompson, 0034, 0035]. Thompson's web page comprising a link to additional advertisements reads on Applicant's claimed redirection information. Thompson discloses that the advantage of this intercept feature allows advertisements to be delivered independently of the actually requested content [0034]. Thus, the advertisements are featured more prominently in Thompson's system than in Schmid which "greatly enhances the likelihood that a user will be present to view an advertisement delivered to the visual display" [Thompson, 0008].

In weighing Thompson and Schmid's teaching, one of ordinary skill in the art would have been greatly motivated to modify Schmid's invention with Thompson's interception functionality to improve the commercial benefits of Schmid's system which only allows display of advertisements simultaneous with the requested content. Thompson in fact describes a version of Schmid's system in his background [0003]. Therefore, one of ordinary skill in the art would have considered Thompson to provide an enhancement to Schmid's system. Based on the foregoing, Applicant's arguments are not persuasive and the rejection set forth in the previous action is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 43, 48-50, and 52-54 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid et al, U.S. Patent No. 6,438,578 ["Schmid"], in view of Thompson et al, U.S. Patent Publication No. 2002/0077900.

5. As to claims 43 and 54, Schmid does not disclose that the intercepting, creating, and transmitting steps occur prior to an initial request for initial content made by a requesting device arriving at an intended destination. However, performing such steps prior to delivering an initial request to an intended destination was a well known feature in the art at the time of Applicant's invention. For example, Thompson discloses such a feature in his invention directed to providing interstitial advertising. Specifically, Thompson discloses intercepting the initial request and transmitting information prior to an initial request for initial content made by a requesting device arriving at an intended destination [0034].

Thompson discloses that such a feature has the advantage of insuring that a client actually views the advertising content instead of the actual requested content [0008]. Thus, based on Thompson, one of ordinary skill in the art would have been motivated to modify Schmid's invention such that the intercepting, creating, and transmitting steps occur prior to delivering the initial request for initial content to the intended destination. Schmid's invention would be improved as secondary content would have a greater likelihood of being viewed by the client thus increasing the effectiveness of the delivery system.

6. As to claims 43 and 54, Schmid discloses a method in a communications device for delivering content, the method comprising the steps of:

maintaining access to a plurality of second content addresses, each second content address identifying secondary content located at a respective secondary content source [column 6 «lines 41-56»];

prior to an initial request for initial content made by a requesting device arriving at an intended destination [Thompson, 0034], the intended destination comprising an initial content source [Figure 1 «items 14, 24, 12» | column 10 «lines 17-21»];

intercepting the initial request [Figure 1 «item 24» | column 9 «lines 65-67»
where : interception means intercepts a packet intended for the requested information source | column 10 «lines 17-21»];

creating redirection information by processing at least one request criteria extracted from the intercepted initial request to determine an identity of secondary content to be retrieved by the requesting device [column 6 «lines 48-50» where : Schmid does not expressly disclose extracting request criteria. However, Schmid discloses that the advertisements are "related in some way to the requested information." This teaching implies extracting from the requested information some criteria in order to retrieve the related advertisements]; and

transmitting the redirection information to the requesting device [column 6 «lines 41-44» : instructions cause the client to request the supplemental information & Thompson, 0035, providing a web page with links that redirect the client to the additional advertisements].

7. As to claim 48, Schmid as modified by Thompson discloses creating redirection information includes:

concatenating a first redirection code and at least one second redirection code; the first redirection code operable to instruct the requesting device to reinitiate retrieval of the initial content; the at least second redirection code operable to instruct the requesting device to initiate retrieval of the second content [column 6 «lines 8-28 and 41-44» where : Schmid's request instructions for the requested information and the supplemental information read on Applicant's redirection code];

including a delimiter separating the first redirection code and the redirection code [column 6 «lines 8-28 and 41-44» where : Schmid does not expressly disclose a delimiter. However, a delimiter is merely a character or series of characters to mark a boundary between regions in a data stream such as a within a packet. Delimiters are well known in the art and are necessary to enable a requesting device to differentiate between the request instructions for the requested information and the supplemental information. Therefore, a delimiter separating the codes is implied].

8. As to claim 49, Schmid as modified by Thompson discloses:

including an address of the initial content source in the first redirection code [column 5 «lines 28-35»; and

including an address of the at least one secondary content source in the second redirection code [column 6 «lines 41-47»].

9. As to claim 50, Schmid as modified by Thompson discloses:

providing a command to the requesting device via the redirection information to concurrently retrieve the initial content during retrieval of the secondary content [column 6 «lines 8-28 and 41-44»: the format and request instructions cause the requesting device to request both the requested and supplemental information].

10. As to claim 52, Schmid as modified by Thompson discloses:

determining the identity of the secondary content relative to at least one of a geographic indication, a source indication, and a content indication in the at least one request criteria extracted from the intercepted initial request [column 6 «lines 48-50»].

11. As to claim 53, Schmid as modified by Thompson discloses intercepting the initial request at an entry point to the Internet [Figure 1 «item 10»].

12. Claims 44-47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid and Thompson, in view of Bandera et al, U.S. Patent No. 6,332,127 [“Bandera”].

13. As to claim 44, Schmid as modified by Thompson does not expressly disclose extracting the at least one request criteria from at least one protocol header and matching the extracted request criteria to at least one of the plurality of secondary content addresses. However, such a feature was well known in the art at the time of Applicant’s invention. For example, Bandera the claimed features. Specifically, Bandera discloses extracting a request criteria from the least one

protocol header on the intercepted initial request [column 6 «lines 57-60» | column 7 «lines 9-17» : location information is conveyed within the HTTP header]. Bandera also discloses matching the at least one extracted requested criteria to at least one of the plurality of secondary content addresses [column 7 «lines 20-27» : plurality of advertising objects that are mapped to location information].

It would have been obvious to one of ordinary skill in the art to have modified Schmid to include the extraction and matching functionality as taught in Bandera. One would have been motivated to adapt Schmid as Bandera teaches that such functionality provides the ability to provide relevant advertisements to a user based on the extracted criteria (location).

14. As to claim 45, Schmid as modified by Thompson does not expressly disclose the matching feature in claim 44 further includes determining desirable secondary content by identifying at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria or capturing an address from the at least one of the plurality of secondary content addresses. However, these features were well known in the art at the time of Applicant's invention.

Bandera discloses both:

determining desirable secondary content by identifying at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria [column 7 «lines 24-27» : lookup table with associations between advertising objects and location information]; and

capturing an address from the at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria [column 7 «lines 28-40»].

It would have been obvious to one of ordinary skill in the art to have modified Schmid with Bandera's teachings of identifying secondary content addresses that are mapped to the requests in order to tailor the secondary content to user interests. One would have been motivated to adapt Schmid as Bandera teaches that such functionality provides the ability to provide relevant advertisements to a user based on the extracted criteria (location).

15. As to claim 46, Schmid as modified by Thompson does not expressly disclose identifying at least one of the plurality of secondary content addresses including at least one of identifying content based on a source, geographic, or content indication related to the at least one extracted request criteria.

Bandera discloses identifying content that has at least one geographic indication related to at least one geographic location of the communications device or from the at least one extracted request criteria [column 7 «lines 32-40»]. It would have been obvious to one of ordinary skill in the art to have modified Schmid with Bandera's teachings of identifying secondary content addresses related to the geographic location of the communications device. One would have been motivated to adapt Schmid as Bandera teaches that such functionality provides the ability to provide relevant advertisements to a user based on the extracted criteria (location).

16. As to claim 47, Schmid as modified by Thompson discloses capturing at least one Internet address for at least one advertisement that is related to the at least one extracted request criteria, the at least one advertisement programmed to be displayed with respect to a display of the initial content [column 6 «lines 48-50» where : Schmid does not expressly disclose extracting request criteria. However, Schmid discloses that the advertisements are "related in some way to the requested information." This teaching implies extracting from the requested information some criteria in order to retrieve the related advertisements]. Also, see Bandera [column 7 «lines 15-27»].

17. Claim 51 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid and Thompson, in view of Subramaniam.

18. Schmid as modified by Thompson does not expressly disclose providing to a delimiter to be detected by the requesting device, such detection indicating to the requesting device an existence of a secondary content condition. However, such a feature was well known in the art at the time of Applicant's invention. For example, Subramaniam discloses providing a delimiter to be detected by the requesting device, such detection indicating to the requesting device an existence of a secondary content condition [column 7 «lines 12-20 and 47-58»]. It would have been obvious to one of ordinary skill in the art to have modified Schmid's system to include the delimiter feature as taught in Subramaniam. Subramaniam discloses that the delimiter enables two different URLs to be sent as a single URL.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2152

/Bunjod Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152